REMARKS

INTRODUCTION

In accordance with the following, reconsideration of the allowability of the pending claims is respectfully requested.

Claims 1, 3-7, 13 and 15 are pending and under consideration.

REJECTION UNDER 35 USC §112

Claims 3-6 stand rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action indicates that the phrase "so that monitor information is readable by the computer" is indefinite because it is unclear how this corresponds to the claimed predetermined signal, "the on condition", the "off condition", or "both the on and off conditions." This rejection is respectfully traversed.

Here, it is respectfully submitted that the Office Action's interpretation of the phrase:

"wherein the predetermined signal is transmitted to the monitor, regardless of whether the monitor is powered on or off,"

is unreasonable in view of the present specification and a common understanding of the phrase "regardless of whether the monitored is powered on or off".

The term "regardless of whether" must be interpreted in conjunction with "the monitor is powered on or off."

Here, applicants have not claimed an "on condition", an "off condition", or both an "on and off conditions," as suggested in the Office Action. Rather, consistent with the specification, applicants have claimed the phrase X is performed "regardless of whether the monitor is powered on or off," i.e., it doesn't matter whether the monitor is powered or on, and it doesn't matter whether the monitor is powered off, it is "irrespective" of such a happening.

The Office Action's miss-interpretation of the claimed phrase is due to the Office Action's attempt to read the claim terms in view of the alternative, in an attempt to read the claim terms more broadly than their original intent.

However, the specification clearly provides support that this phrase of X being performed "regardless" of whether the monitor is on or off means that X is performed regardless of the one and off state of the monitor.

As a general proposition, claim limitations are to be interpreted in light of its broadest reasonable interpretation. In re Prater, 162 USPQ 541, 550-51 (CCPA 1969), cited with approval, In re Morris, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997). Further, the claims should be interpreted in light of their plain meaning as understood by one of ordinary skill in the art. In re Zletz, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989),citing, In re Prater. **However, the broadest reasonable interpretation must also conform to the broadest reasonable interpretation afforded by one of ordinary skill in the art *when read in light of the specification*.** In re Prater, 162 USPQ 541, 550-51, In re Morris, 44 USPQ2d at 1027, MPEP 2111.01 (7th Ed., rev. 1)(Feb. 2000).

Further, as stated in Honeywell Inc. v. Victor Co. of Japan Ltd., 63 USPQ2d 1904 (CA FC 2002) "The district court erred in not according more weight to the inventor's definition. It is well settled that a patentee may define a claim term either in the written description of the patent or, as in the present case, in the prosecution history. Mycogen Plant Science v. Monsanto Co., 243 F.3d 1316, 1327, 58 USPQ2d 1030, 1039 (Fed. Cir. 2001). ***Frequently, a definition offered during prosecution is made in response to a rejection, and is entered in conjunction with a narrowing amendment***. See, e.g., Southwall Techs., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1677 (Fed. Cir. 1995). ***Such a definition limits the scope of the claim, preventing the patentee from later recapturing what was previously surrendered. Although the inventor's definition does not have a narrowing effect, it is nonetheless relevant in indicating the meaning that the inventor ascribed to the term***. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996) ('[T]he record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims.'); E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1438, 7 USPQ2d 1129, 1135 (Fed. Cir. 1988) (prosecution history 'must be examined to ascertain the true meaning of what the inventor intended to convey in the claims') Honeywell Inc. v. Victor Co. of Japan Ltd., 63 USPQ2d 1904 (CA FC 2002).

Accordingly, the aforementioned "wherein the predetermined signal is transmitted to the monitor, regardless of whether the monitor is powered on or off," is clear and definite in view of the above and the present specification.

Withdrawal of this rejection is respectfully requested.

CITATION TO KSR

In response to applicants previous remarks, the Office Action has cited the recent KSR decision from the Supreme Court to support of both the correctness of using an "obvious to try" principle and a principle that evidence of teaching/suggestion/motivation is not needed to be evidenced in the record.

In particular, the Office Action has summarized the holding of KSR as:

"[t]he Supreme Court ruled that applicant is not entitled to [such] a liberal interpretation of what should be patentable. Graham v. John Deere controls obvious inquires not a rigid application of the teaching/suggestion/motivation test. Teaching/suggestion/motivation test as a litmus test for obviousness is inconsistent with the Graham framework. Rigid preventive rules that deny factfinders recourse to common sense are neither necessary under our case law nor consistent with it. Where there is a design need or market pressure to solve a problem and there are finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp."

Applicants respectfully submit that this brief summary of KSR is incompatible with the actual underlying holding.

The particular discussion in KSR regarding "rigid" application of the teaching/suggestion/motivation (tsm) test was ruling against a lower court's requirement that the Examiner's cited motivation be the same motivation relied upon by the inventor of the underlying patent, i.e., the Supreme Court reaffirmed that the "reason" used for combining two references does not have to be the same as the inventors reason. This was one of the primary reasons against the "rigid" interpretation of the tsm test.

In this regard, here, the Supreme Court actually emphasized that *the typical previous use of the tsm test **was** appropriate* and capable of determining whether a claimed invention is obvious, or not.

The Supreme Court further reaffirmed that evidence is required, i.e., mere conclusory statements are insufficient.

The Supreme Court reaffirmed In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006), which stated: "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

As further stated by the Supreme Court, and apparently relied upon in the Office Action:

"Often it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of the demands known to the design community or present in the market place; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit."

Here, again, the Office Action's citation to KSR that any reason is sufficient to support a conclusion of obviousness is incorrect.

For example, though KSR discussed potential "market pressure" or "design need", and that these elements can be used to support a conclusion of obviousness, or non-obviousness, this does not mean that a mere statement that there would have been or was a market pressure or design need is sufficient, rather, again, the Examiner must provide evidence of such elements to support the obviousness decision.

Similarly, though the Supreme Court indicated that the principle of "obvious to try" may be available, the Supreme Court set out particular guidelines, i.e., that there must be a finite number of identified predictable solutions and one skilled in the art would have been led to try one of those solutions.

The Supreme court did not state that the "obvious to try" principle is available anytime without any such evidence.

Accordingly, the cited KSR decision still requires the Examiner to provide evidence to support the underlying determination of obviousness. Again, the Supreme Court restated that conclusory statements are insufficient.

Thus, the lone statement that it would have been obvious to modify a reference to operate differently than originally designed to have a feature not originally anticipated merely because it would then have that feature is insufficient.

Further, despite the Office Action's apparent indication that the Examiner's decision of what would have been "common sense" is all that is needed to sustain an obviousness conclusion, applicants again note that this is contrary to both the KSR decision and the previous Supreme Court decision in Zurko, which clarified that the PTO must conform with the Administrative Procedures Act (APA), which requires that evidence of a decisions be in the record, or those decisions are arbitrary.

Again, evidence of a "reason" why one skilled in the art would have added a feature from a second reference to a system of a first reference, merely to now have that second feature,

without further evidence in the record in inappropriate.

Here, regarding the reliance on "common knowledge" in concluding obviousness, it is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding of experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of ***"common knowledge" and "common sense"*** may only be applied to the analysis of evidence, rather than be a substitute for evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

KSR does not change these decisions.

Evidence must be presented in the record.

In addition, as noted below, the Office Action has failed to provide support for **both** required "reasons" for modifying the primary reference, i.e., (1) evidence in the record supporting the obviousness of adding the missing feature into the primary reference; and (2) evidence in the record supporting the obviousness of further modifying the modified primary reference to further perform as claimed.

COMBINATION OF FAMILIAR ELEMENTS

In addition, it is further respectfully submitted that the Office Actions proposed modification Kim et al. US Patent No. 5,961,647, to perform the claimed operations through interaction with a memory in a monitor, that operation not being suggested in either of Kim et al. or the further relied upon Chaiken et al., US Patent No. 6,223,283, based merely upon a teaching by Chaiken et al. that such a memory exists, is inappropriate.

The fact that a memory exists in the system of Chaiken et al. should only be used to to support a conclusion that it would have been obvious to use a memory in Kim et al.

The additional "leap" provided in the Office Action of now taking that newly added memory and performing the claimed operation based upon the claimed predetermined signal, is not supported by any evidence in the record.

Further, this leap cannot be considered the same as a merely swapping in of the additional memory element of Chaiken et al.

The Office Action is not suggesting that the memory of Chaiken et al. be added to the system of Kim et al. to perform its usual familiar functions, or anticipated functions.

Rather, the Office Action is suggesting that if you added the memory of Chaiken et al. to the system of Kim et al., then the claimed invention would then have been further obvious, i.e., **two "reasons" for modification** are being presented.

The first modification is the addition of the memory to Kim et al., and the ***second*** modification is the further using of that memory in the claimed manner.

Thus, here, even if it were obvious to add the memory of Chaiken et al. to the system Kim et al., to perform familiar operations, there is no evidence in the record of the required ***second*** "reason" for the ***second*** modification.

REJECTION UNDER 35 USC §103

Claims 1, 3-7, 13 and 15 stand rejected under 35 USC §103(a) as being obvious over Kim et al., US Patent No. 5, 961,647, in view of Chaiken et al., US Patent No. 6,223,283. This rejection is respectfully traversed.

With regards to claim 1, for example, the Office Action sets forth several of the below indications of features disclosed by either of Kim et al., Chaiken et al., or by "well known" sources.

By way of review, independent claim 1 sets forth:

> "[a]n apparatus for controlling the power of a monitor, comprising:
> a computer outputting a predetermined signal when the computer is powered on or off;
> a monitor receiving the predetermined signal and powering on or off according to the predetermined signal; and
> a video card processing and transmitting a video signal to the monitor;
> wherein the predetermined signal output from the computer is output from a predetermined pin of the video card,
> wherein the predetermined signal is transmitted to the monitor, regardless of whether the monitor is powered on or off, and
> wherein, if the monitor is powered off, a memory of the monitor is powered by the predetermined signal to provide the computer monitor information stored in the memory.

First, regarding Kim et al., the Office Action indicates that Kim et al. discloses all the claimed features except that "Kim et al. fails to explicitly teach the monitor including a memory

storing monitor information wherein the information is provided to the computer whether the monitor is powered on or off as claimed."

Here, FIGS. 4 and 5 of Kim et al. illustrate a computer system supplying data to a monitor through cable lines 300 and power supply 120 of the computer system further providing a 5V signal to the monitor, and in particular to the monitor on/off power switching circuit 250. As illustrated in FIG. 4, the 5V signal may be provided to a MICOM microcomputer (separate from the switching circuit 250), with the MICOM controlling the sending of on/off control signals to the switching circuit 250 to control on/off power supply.

Here, it is noted that Kim et al. does not appear to set forth any further capabilities or requirements for the MICOM other than controlling the on/off control signals.

Next, beginning on page 4, the Office Action sets forth that Chaiken et al. "teaches that it is known to provide a monitor with a memory storing monitor information and that it is conventional for the BIOS to read/download the monitor information in a monitors ROM during initialization," citing FIG. 2 and col. 1, lines 45-59, of Chaiken et al.

Briefly, this type of EDID data discussed in Chaiken et al. is stored in a ROM which may typically be a PROM or EPROM.

After pointing out that Chaiken et al. discloses the storage of such EDID data in a memory in the monitor, the Office Action again repeats that a focus of Kim et al. is to reduce undue power and that the above-mentioned MICOM can be used with a switching circuit to reduce overall power usage.

Then, further on page 4, the Office Action sets forth a ***first*** proposed obviousness modification of Kim et al., stating that it would have been obvious to modify Kim et al. to have the memory of Chaiken et al. "in order to provide the computer and BIOS with monitor information for initializing and configuring the computer."

Directly, thereafter on page 4, the Office action sets forth a ***second*** proposed obviousness modification of the modified Kim et al., i.e., the modified Kim et al. with the ROM having the EDID information, stating "it would have been obvious ... to locate the memory with the MICOM switching circuit components and power the memory from the 5 volt power signal of Kim in order to provide power to the memory whether the monitor is powered on or off because this would allow the monitor to remain off during computer initialization and configuration there by reducing the power consumed by the monitor."

Thereafter on page 5, the Office Action states that "it is well known in the art that microcomputer such as MICOM in display 200 typically include read only memory and it would have been obvious to one of ordinary skill in the art to use the MICOMs ROM for storing Chaiken's EDID file."

Again, on page 5, the Office Action further states "[i]t would have been obvious...to locate/store the EDID file in the ROM of the monitors MICOM microcomputer in order to take advantage of the microcomputers independent power source and display power management functionality."

Thus, in summary, the Office Action has indicated that because Chaiken et al. indicates that monitors can have a memory with EDID information, it would have been obvious to particularly place that memory in the MICOM of Kim et al. so that a computer connected to the monitor could boot-up without having to startup the monitor while still accessing the memory.

Again, this is a two-stepped leap of ***first*** adding the memory of Chaiken et al. to the monitor of Kim et al., and then ***secondly*** placing that memory within the ***only*** element within Kim et al. that is powered when the monitor is powered down.

However, the Office Action's second premise, that it would have been obvious to place the particular memory within the MICOM of Kim et al., would not appear to be supported by the record, other than the Examiners conclusion that such a placement would be beneficial, would work, and would accomplish the goals indicated.

Conversely, there is no particular reason in the record to move any placement of any memory of the monitor of Kim et al. to the MICOM, or to place a copy of such information in an additional memory within the MICOM of Kim et al.

The Office Action has placed the disclosed elements of the monitor system of Kim et al. in a vacuum, i.e., the Office Action has not taken into consideration that the monitor of Kim et al. may already have the above-indicated PROM or EPROM, e.g., associated with the video signal processor 220.

The video signal processor 220 of Kim et al. would mostly likely be the logical placement for such data.

For example, see the attached U.S. Publication 20070024607, particularly stating that such EDID data is integrally associated the video processing elements of a monitor.

In addition, the Office Action indicates that it would be desirable to have the monitor remain off while a PC is initializing "to save power".

However, this is the opposite of the focus of Kim et al., which emphasizes that power should be reduced upon inaction or non-activity, and power should be returned upon a return to action or activity. Thus, there would not appear to be a need to have the monitor off while initializing, at least based upon the disclosure of Kim et al.

Further, it would appear counter-intuitive for a monitor connected to a PC to be in an "off" mode when a computer is being initialized.

There appears to be a recent drive to increase the initializing process of computers so they boot up quicker and quicker, and with there being some required start-up time for monitors, it would not appear intuitive to keep the monitor off while trying to speed up the on-screen display to a user.

Similarly, with operating systems there is typically a substantial amount of information that may be provided to the user during the initializing process, to let the user know what processes of the initialization are being performed.

Thus, it would not appear obvious to keep the monitor off while initializing the PC.

The Office Action has also indicated that it is "well known" that microcomputers like the MICOM of Kim et al. have ROM memories. In this regard, applicants respectfully request the Examiner provide a reference supporting this interpretation and particularly point out the similarities between the relied upon MICOM that may have a memory and the MICOM of Kim et al.

Conversely to the Office Action's premise, it would appear that the MICOM of Kim et al. would preferably be as simple as possible, and the addition of a memory with such EDID data would only serve to complicate this MICOM. Further, as noted above, the MICOM of Kim et al. would not appear to be set forth in Kim et. al. for substantially more than the on/off controlling operation set forth in Kim et al.

Further, with the addition of the EDID data to the MICOM of Kim et al. the underlying physical structure of Kim et al. will most likely have to be changed, i.e., as noted above the monitor of Kim et al. probably already has a memory with such EDID data and electrical connection between the systems previously relying on that memory having to be reconfigured, or a duplicate of that memory will have to be made for placement in the MICOM of Kim et al.

Still further, counter to the Office Action's premise that it would have been obvious to add a memory to the MICOM of Kim et al, such an addition would actually appear to not be desirable.

This addition of the memory will increase costs, increase power usage, and increase complexity. All of these factors would appear to teach away from the proposed belief presented by the Examiner that it would have been obvious to add such a memory.

Lastly, as noted above, the Office Action's second obviousness rationale is not supported by the record of the present application.

Though the Office Action has provided a reference showing the use of EDID data in a monitor, and the placement of that data in a memory within a monitor, there is no evidence in the record to place that memory with a MICOM being used to control on/off power supply for the remainder of the monitor.

The remaining independent claims set forth similar features with differing scope and breadth.

Accordingly, withdrawal of this rejection and allowance of all pending claims is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: August 22, 2007

By: _____

Stephen T. Boughner
Registration No. 45,317

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501